UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,069	02/05/2004	Emrys Williams	5681-74900	6049

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EXAMINER
DADA, BEEMNET W

ART UNIT	PAPER NUMBER
2435	

NOTIFICATION DATE	DELIVERY MODE
11/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 July 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36,38-52 and 54* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-36,38-52 and 54* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

In view of the Appeal Brief filed on 07/01/2009, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a

supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or

1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claims 1-36 and 38-52 and 54 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-35, 38-52 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. The specification fails to mention or teach the limitation wherein transmitting a response to a remote authorization unit to authenticate a response <u>without transmitting the</u> <u>passcode to the remote authorization unit and without generating the passcode from the user</u> <u>input prior to said transmitting</u>.

Claims 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention or teach the limitation wherein validating the user on the basis of said response compared to the predicted response, wherein <u>neither the response nor the</u> <u>predicted response is the pass code.</u>

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-36 and 38-52 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 18, 35, 36 and 38 the phrase "capable of" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16, 18-33, and 35-53 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Hoover (US 6,209,102)**, hereafter "Hoover" in view of Weiss (US 5,023,908).

Considering **Claims 1 and 35,** Hoover discloses a method of accepting a pass code

(abstract), comprising: providing a user with a machine-generated challenge (column 2- lines

44-46); and receiving, from a user-input device, user input that transforms the machine-

generated challenge into a pass code allocated to the user (column 2- lines 47-52), wherein the

user input is dependent on the machine-generated challenge such that the user input to

transform the machine-generated challenge into the pass code is different for different machine

generated challenges (column 3- lines 11-19); generating a response to the challenge from the

user input received from the user input device (column 4- lines 34-36), said response allowing

the user to be validated against a stored data record of the pass code (column 4- lines 34-36).

Hoover does not explicitly disclose transmitting the response to a remote authorization unit to

authenticate the response without transmitting the pass code to the remote authorization unit

and without generating the pass code from the response prior to said transmitting.

In the same field of endeavor, Weiss teaches a personal identification system including

transmitting a response to a remote authorization unit to authenticate a response without

transmitting the passcode to the remote authorization unit and without generating the passcode

from the user input prior to said transmitting, said response allowing the user to be validated at

the authorization unit compared to a predicted response based on knowledge of the challenge

and stored data record of the passcode [column 3, lines 45-column 4, line 28]. It would have

been obvious to one having ordinary skill in the art at the time of applicant's invention to employ

the teachings of the Weiss within the system of Hoover in order to enhance the security of the

system.

Considering **Claims 18, 36, and 38,** Hoover discloses a terminal for use in accepting a

pass code (abstract), comprising: an output for providing a user with a machine generated

challenge (column 2- lines 44-46); a user input device for receiving user input that transforms

the challenge into a pass code allocated to the user (column 2- lines 47-52), wherein the user

input is dependent on the machine-generated challenge such that the user input to transform

the machine-generated challenge into the pass code is different for different machine generated

challenges (column 3- lines 11-19), generate a response to the challenge from the user input

received from the user input device, said response allowing the user to be validated against a

stored data record of the pass code; and transmitting the response to a remote authorization

unit to authenticate the response (column 2- lines 56-61).

Hoover does not explicitly disclose without transmitting the pass code to the remote

authorization unit and without generating the pass code from the response prior to said

transmitting.

In the same field of endeavor, Weiss teaches a personal identification system including

transmitting a response to a remote authorization unit to authenticate a response without

transmitting the passcode to the remote authorization unit and without generating the passcode

from the user input prior to said transmitting, said response allowing the user to be validated at

the authorization unit compared to a predicted response based on knowledge of the challenge

and stored data record of the passcode [column 3, lines 45-column 4, line 28]. It would have

been obvious to one having ordinary skill in the art at the time of applicant's invention to employ

the teachings of the Weiss within the system of Hoover in order to enhance the security of the system.

Considering **Claims 2, 19, and 39,** Hoover discloses challenge is independent of said pass code (column 3- lines 11-17).

Considering **Claims 3, 20, and 40,** Hoover discloses generating a new challenge for each user validation (column 3- lines 13-16).

Considering **Claims 4, 21, and 42,** Hoover discloses challenge is generated on a random basis (column 3- lines 13-16).

Considering **Claims 5, 22, and 41,** Hoover discloses challenge is generated in response to receiving a request from a user for validation (column 1- lines 1-14, column 3- lines 11-12, column 4- lines 17-18, it is inherent that for access to an electronic service, a request for authorization would be received (i.e. access to an ATM or the like)).

Considering **Claims 6, 23, and 43,** Hoover discloses providing a user with a challenge comprises displaying the challenge to the user (column 2- lines 44-46).

Considering **Claims 7, 24, and 44,** Hoover discloses the challenge is displayed to the user in such a manner as to prevent third parties from viewing the challenge (column 3- lines 1-10).

Considering **Claims 8, 25, and 45,** Hoover discloses the response from the user is received as a set of one or more modifications to be applied to the challenge so that it matches the pass code allocated to the user (column 2- lines 44-52).

Considering **Claims 9, 26, and 46,** Hoover discloses the set of one or more modifications is received as directional input from the user (column 2- lines 50-52).

Considering **Claims 10, 27, and 47,** Hoover discloses the directional input is received as the result of the user pressing one or more arrow keys that increment or decrement the challenge by a fixed amount (column 2- lines 50-52).

Considering **Claims 11, 28, and 48,** Hoover discloses challenge has the same number of characters as the pass code allocated to the user (column 2- lines 47-48).

Considering **Claims 12, 29, and 40,** Hoover discloses transformation is specified individually for each character of the challenge (column 2- lines 48-52).

Considering **Claims 13, 30, and 50,** Hoover discloses receiving an indication from the user that the transformation for a different character is about to be entered (column 2- lines 48-52).

Considering **Claims 14, 31, and 51,** Hoover discloses receiving an indication from the user that the response has been completely entered (Fig. 2- Submit).

Considering **Claims 15, 32, and 52,** Hoover discloses generating an entered pass code from the challenge and from the response (column 3- lines 11-19).

Considering **Claims 16, 33, and 53,** Hoover discloses the response is validated by comparing the generated pass code with the stored data record of the pass code (column 1- lines 6-14).

2.   **Claims 17, 34, and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoover** in view **Weiss** and further in view of **Funk (US 5,721,779),** hereafter "Funk".

Considering **Claims 17, 34, and 54,** Hoover discloses receiving a communications challenge from the remote authorization unit that has access to said stored data record of the pass code (column 1- lines 6-14, column 2- lines column 44-47); thereby allowing the response input by the user to be validated by said authorization unit against said stored data record of the pass code (column 4- lines 34-36).

Hoover is silent on using the response to encrypt said communications challenge; and

transmitting the encrypted communications challenge to the remote authorization unit, thereby

allowing the response input by the user to be validated by said remote authorization unit using

said stored data record of the pass code.

Funk discloses using the response to encrypt said communications challenge (Funk- column 4-

lines 50-52); and transmitting the encrypted communications challenge to the authorization unit

(Funk- column 4- lines 66-67), thereby allowing the response input by the user to be validated

by said authorization unit against said stored data record of the pass code (Funk- column 4- line

67, column 5- lines 34-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Hoover by using the response to encrypt said

communications challenge; and transmitting the encrypted communications challenge to the

authorization unit as taught by Funk for the benefit of enforcing link security for the

communication link between the client and the server (Funk- column 3- lines 24-26).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to BEEMNET W. DADA whose telephone number is (571)272-3847. The

examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Beemnet W Dada/
Primary Examiner, Art Unit 2435
November 5, 2009